

REMARKS

This paper is filed in response to the November 4, 2005 Office Action. As this paper is filed on January 6, 2006, and within the extended period for response, this response is timely filed.

I. Status of Amendments

Prior to this amendment, claims 54, 56-59, 61-66, 68-71 and 78-83 were pending. By way of this amendment, claims 54 and 66 are amended. Therefore, claims 54, 56-59, 61-66, 68-71 and 78-83 are still at issue.

II. The November 4, 2005 Office Action

A. Claim Objection

The Office Action objected to claim 54 as requiring the indefinite article "a" to be inserted before the words "gaming network." Claim 54 has been so amended. The applicant requests that the objection be withdrawn.

B. Section 112 Rejections

The Office Action rejected claims 54 and 66, and their respective dependent claims 56-59, 61-65, 68-71 and 78-83 under 35 USC § 112, second paragraph, as allegedly indefinite. The applicant has amended claims 54 and 66 to recite that the vote is received from at least one of the players forming the team. The applicant requests that this rejection be withdrawn. Should this not address the examiner's concern, the examiner is invited to call the applicant's agent at the telephone number listed at the end of this paper.

C. Section 103(a) Rejections

The Office Action rejected claims 54, 56-59, 61-65, 68-71 and 78-83 as being unpatentable under 35 USC § 103(a) over Vancura (United States Patent No. 6,769,986) in view of Walker (United States Patent No. 6,394,899) in further view of LaMura (United States Patent No. 6,676,521), or Olsen (United States Patent No. 6,217,448), or LaMura and

Walker (United States Patent No. 6,193,606). The applicants respectfully traverse and request reconsideration.

There is no motivation to combine the teachings of Vancura and Walker ('899). Indeed, the stated goal of Vancura teaches away from a combination with Walker. Vancura states at Col. 2, lines 55-61, "What is proposed herein is an entirely different approach in which the player customizes the play of the game. The player proactively chooses an aspect of the bonus game (such as, one of several games or one of several options within a game) preferably before initiating play on the base game, during play of the base game or at entry to bonus play." Vancura teaches that the player is actively involved in selecting aspects of the bonus game. Vancura encourages play by giving the player an opportunity to improve the odds by selection of game aspects advantageous to the player because of knowledge or background.

Walker, on the other hand, removes control from the player and categorizes players according to levels, as quoted by the examiner at Col. 2, lines 53-56. By categorizing players, Walker attempts to level the playing field by evaluating skill areas and compensating for them. There is simply no motivation to combine the bonus game of Vancura and the trivia game of Walker to achieve a game in accordance with the current disclosure. Only by starting with the current disclosure and working backward, would one arrive at a combination of Vancura and Walker. The Federal Circuit has repeatedly stated that the motivation to combine must be found in the references and not by hindsight. In *re Rouffet*, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) the Federal Circuit explained:

To reject claims in an application under section 103, an examiner must show an un rebutted prima facie case of obviousness. In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent.

Id. at 1455 (citations omitted). In the Rouffet case, the examiner had rejected the pending claims on a combination of references. The Board sustained the examiner. However, the Federal Circuit reversed the Board's decision and ruled that the examiner's rejections were legally impermissible because they failed to demonstrate a suggestion for combining the references in the manner proposed by the examiner.

As explained by the Federal Circuit:

As this court has stated, "virtually all [inventions] are combinations of old elements." Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.


Id. at 1457 (citations omitted).

Because there is no suggestion to combine the references of Vancura and Walker, the examiner has not met the burden of a showing a *prima facie* case of obviousness and the applicant requests the rejection of independent claims 54 and 66 and their corresponding dependent claims 56-59, 61-65, 68-71 and 78-83 be withdrawn.

In view of the above amendment, applicant believes the pending application is in condition for allowance. No fees are believed due, but should a fee be required, the Commissioner is directed to Deposit Account 13-2855. Should the examiner have any questions regarding this response, the examiner is invited to call the applicant's agent at the telephone number listed at the end of this paper.

Dated: February 6, 2006

Respectfully submitted,

By 
Jeffrey K. Berger

Registration No.: 51,460
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Agent for Applicant